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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,386	05/22/2000	William T. Carden JR.	35672-163980	1657

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EXAMINER

HILLERY, NATHAN

ART UNIT PAPER NUMBER

2176

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/576,386	CARDEN, WILLIAM T.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nathan Hillery	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 21, 22, 24-33, 35-38, 40-49, 51-54, 56-65, 67 and 68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 22, 24-33, 35-38, 40-49, 51-54, 56-65, 67 and 68 is/are rejected.
- 7) ☒ Claim(s) 22, 25, 35, 38, 41, 51, 54, 57 and 67 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*HL*

### DETAILED ACTION

1. This action is responsive to communications: RCE filed on 4/1/05.
2. Claims 21, 22, 24-33, 35 - 38, 40 - 49, 51 - 54, 56 - 65, 67 and 68 are pending in the case. Claims 21, 37, and 53 are independent.

#### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/1/05 has been entered.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 21 – 36; 37 – 52; and 53 – 68 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable

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over claims 25 – 36, 39 – 42; 43 – 54, 57 – 60; and 61 – 72, 75 – 78 respectively of copending Application No. 09/576,386. The conflicting claims are identical except that the instant application discloses publishing a manuscript and the co-pending application discloses publishing a submission; therefore, the applications are not patentably distinct from one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Objections***

6. Claims 22, 25, 35, 38, 41, 51, 54, 57, and 67 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 21, 37, and 53 are Markush claims; therefore, it is only necessary to follow one path as set forth in those claims. The path(s) limited by the aforementioned dependent claims may or may not be followed; thus, the aforementioned dependent claims do not fully further limit the parent claim(s) from which they depend. Consequently, no further action on the merits with respect to the dependent claim(s) either in part as a whole will be taken by the Office at this time.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 21 – 68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. **Regarding independent claims 21, 37, and 53**, the metes and bounds of the claims cannot be determined because of the various alternatives presented (use of or-clauses) in the claims. Due to the Markush nature of many of the limitations, the claims are unclear; in addition, some limitations lack antecedent basis depending on what path is taken. Thus, depending on what particular path(s) is/are followed certain limitations and/or depending claims will not be considered further on the merits either as a whole or in part. See the section claim objections above for further clarity regarding treatment of the dependent claims.

10. **Regarding the dependent claims w/in claims 21 – 68**, the claims are rejected for fully incorporating the deficiencies of the base claim(s) from which they depend.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 21, 26 – 33, 37, 42 – 49, 53, and 58 – 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ivanov (previously cited) and further in view of Leone et al. (cited by Applicant) and Plantz et al. (as cited by Applicant).

13. **Regarding independent claim 21**, Ivanov teaches that *in order to build a particular workflow application, a designer provides facilities to create, store, access, modify, delete documents and reviews, typically using a database management system. Each logical document and/or review can be implemented using a plurality of physical records. In the current embodiment, a document/review is implemented as a single Lotus Notes document, and all document related operations are provided by the Lotus Notes environment (2) defines the data components in the structure of each document and review. Document 44 stores data components for each role 48 and stage 50 relevant for its particular contents (Column 16, lines 20 – 31), compare with receiving a manuscript at a computer system, wherein said computer system includes at least one database to store a plurality of submissions, and wherein said plurality of submissions includes at least one of said manuscript, correspondence, a review, descriptive information, or a decision; and storing said manuscript in said computer system, wherein said manuscript is accessible to a plurality of clients, wherein said plurality of clients includes an author of said manuscript, a reviewer, an editor, or a staff person managing one or more publications; that modifications in the review authorizations between the moment the document is submitted and the moment reviews are requested can be reflected in the review process; in this respect, the reviewer list can be computed using the programming language just before notifications are sent out (Column 6, lines 14 – 19), compare with receiving a selection of at least one reviewer for said manuscript from a list of reviewers, wherein said list of reviewers is maintained by said computer system and providing access to*

**said manuscript to said at least one reviewer;** and that *if at any time when it is a reviewer's turn to evaluate a proposal he/she composes a rejection, then the proposal itself is rejected. The preparer can choose to modify the proposal and resubmit it as a revision. The new proposal will go through the same approval process like the original one* (Column 27, lines 15 – 22), compare with **receiving one or more reviews including at least one of a revised manuscript, correspondence, comments, recommendations, a score, relevant information or said decision, wherein said decision is about at least one of accepting, rejecting, or requesting revisions to said manuscript.** Ivanov teaches that *workflow manager 30 again examines document 44 and its associated reviews 46, and eventually deposits another notification 42 into system mail box 34. The process continues until document 44 is declared reviewed* (Column 7, lines 64 – 67), compare with **reporting said one or more reviews about said submission.** Ivanov does not explicitly teach **translating...** However, Leone et al. teach that *the preferred embodiment of the invention is illustrated with regard to a special agent process that converts IBM's non-HTML formatted books created by the IBM BookManager Build process into HTML formatted ones. The special agent process will be called "DITA" herein. DITA is the core component process that produces the HTML formatted topics (both text and link anchors) generated by hypertext links. This provides real-time conversion of the non-HTML format to HTML* (Column 5, lines 51 – 59), compare with **translating said manuscript into a common format of said computer system.** It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Ivanov with that of Leone et al.

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because such a combination would allow the users of Ivanov the benefit of *an improved method and means for automatically converting non-HTML text and hypertext links to HTML texts and HTML links in electronically formatted documents for access over communications networks* (Column 1, lines 54 – 58). Neither Ivanov nor Leone et al. explicitly teach **upload** or **browser**. However, Plantz et al. do teach that *an HTML-based word-processing system that allows instant downloading of text to existing pre-press formats, such as Quark or Pagemaker, and uploading of pictures, graphics, video or audio data in any format* (Column 5, lines 36 – 40), compare with **receiving said manuscript includes at least one of (i) receiving a file uploaded to said computer system or (ii) receiving data pertaining to said manuscript provided to said computer system from a browser interface, and that said submission includes data in the form of text, images, graphics, or multimedia**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Ivanov and Leone et al. with that of Plantz et al. because such a combination would allow the users of Ivanov and Leone et al. the benefit of *a method to allow essentially simultaneous viewing of an entire in-process document, which easily can be downloaded for publication in a variety of formats, including but not limited to CD-ROM, hard-copy book, or on-line HTML format* (Column 5, lines 18 – 23).

14. **Regarding dependent claims 26, 28 and 29**, Ivanov teaches that *in the second solution, some reviewers do not have the authority to reject a proposal but they can argue why the proposal should be approved or rejected. Their comments are passed to higher ranking reviewers who can approve or reject a proposal; earlier reviewers also*



*can dynamically modify the workflow by engaging the higher ranking reviewers who otherwise would not be involved in the review process (Column 26, lines 36 – 43), compare with **said list of reviewers is provided to said computer system by one or more of said plurality of clients**, that **one or more of said plurality of clients produces said list of reviewers**, and that **said list of reviewers is based on qualifying criteria**, wherein **said qualifying criteria includes at least one of (i) a reviewer's area of specialty, (ii) a reviewer's prior review history, (iii) a reviewer's professional associations, (iv) a reviewer's availability, or (v) said author's preference for or against one or more reviewers.***

15. **Regarding dependent claims 27**, Ivanov teaches that *the reviewer list can be computed using the programming language just before notifications are sent out (Column 6, lines 17 – 19)*, which provide that **said computer system produces said list of reviewers**.

16. **Regarding dependent claims 30 and 31**, Ivanov teaches that *some of the features of a workflow application built according to the present invention are: (a) provides different access (security) levels based on user's electronic identity, to protect sensitive information from unauthorized users ... (Column 5, lines 14 – 18)*, which provide that **said computer system requires authentication of identity from one or more of said plurality of clients**, and that **said access provided by said computer system requires at least one of identification or authentication**.

17. **Regarding dependent claim 32**, Ivanov teaches that *if at any time when it is a reviewer's turn to evaluate a proposal he/she composes a rejection, then the proposal*

*itself is rejected. The preparer can choose to modify the proposal and resubmit it as a revision. The new proposal will go through the same approval process like the original one* (Column 27, lines 15 – 22), compare with **receiving a revision to said manuscript, wherein the author of said manuscript provided said revision based on said reviews; and providing said revision to said at least one reviewer for additional review.**

18. **Regarding dependent claim 33**, Ivanov teaches that *FIG. 1 is a high level representation of a networked computer system 20, in particular, a Lotus Notes system. Such system connects a number of personal computers 22 and a number of server computers 24, allowing them to communicate. A user seated in front of personal computer 22 can create, access, modify, and delete data which is shared with other users and resides on server computer 24. Each user has an electronic identity and can communicate with other users via an electronic mail system* (Column 7, lines 23 – 31), which provide that **said plurality of clients access said computer system via at least one of the Internet, an internet, or an intranet.**

19. **Regarding dependent claim 36**, Ivanov teaches that *participants do not have to know or select who has to review a document next* (Column 5, lines 32 – 34), compare with **information about at least one of said author or said reviewers is not provided with said submission to one or more of said plurality of clients.**

20. **Regarding independent claim 37**, the claim incorporates substantially similar subject matter as claim 21, and is rejected along the same rationale.

21. **Regarding dependent claim 40**, the claim incorporates substantially similar subject matter as claim 24, and is rejected along the same rationale.
22. **Regarding dependent claim 42**, the claim incorporates substantially similar subject matter as claim 26, and is rejected along the same rationale.
23. **Regarding dependent claim 43**, the claim incorporates substantially similar subject matter as claim 27, and is rejected along the same rationale.
24. **Regarding dependent claim 44**, the claim incorporates substantially similar subject matter as claim 28, and is rejected along the same rationale.
25. **Regarding dependent claim 45**, the claim incorporates substantially similar subject matter as claim 29, and is rejected along the same rationale.
26. **Regarding dependent claim 46**, the claim incorporates substantially similar subject matter as claim 30, and is rejected along the same rationale.
27. **Regarding dependent claim 47**, the claim incorporates substantially similar subject matter as claim 31, and is rejected along the same rationale.
28. **Regarding dependent claim 48**, the claim incorporates substantially similar subject matter as claim 32, and is rejected along the same rationale.
29. **Regarding dependent claim 49**, the claim incorporates substantially similar subject matter as claim 33, and is rejected along the same rationale.
30. **Regarding independent claim 53**, the claim incorporates substantially similar subject matter as claim 21, and is rejected along the same rationale.
31. **Regarding dependent claim 56**, the claim incorporates substantially similar subject matter as claim 24, and is rejected along the same rationale.

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32. **Regarding dependent claim 58**, the claim incorporates substantially similar subject matter as claim 26, and is rejected along the same rationale.

33. **Regarding dependent claim 59**, the claim incorporates substantially similar subject matter as claim 27, and is rejected along the same rationale.

34. **Regarding dependent claim 60**, the claim incorporates substantially similar subject matter as claim 28, and is rejected along the same rationale.

35. **Regarding dependent claim 61**, the claim incorporates substantially similar subject matter as claim 29, and is rejected along the same rationale.

36. **Regarding dependent claim 62**, the claim incorporates substantially similar subject matter as claim 30, and is rejected along the same rationale.

37. **Regarding dependent claim 63**, the claim incorporates substantially similar subject matter as claim 31, and is rejected along the same rationale.

38. **Regarding dependent claim 64**, the claim incorporates substantially similar subject matter as claim 32, and is rejected along the same rationale.

39. **Regarding dependent claim 65**, the claim incorporates substantially similar subject matter as claim 33, and is rejected along the same rationale.

#### ***Response to Arguments***

40. Applicant's arguments with respect to claims 21, 22, 24-33, 35 - 38, 40 - 49, 51 - 54, 56 - 65, 67 and 68 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH

*William L. Bashore*  
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PRIMARY EXAMINER  
*May 31, 2005*